

**REMARKS****I. General**

The issues outstanding in the instant application are as follows:

- The drawings are objected to under 37 CFR §1.83(a);
- Claims 1, 3-8, 10, 12-16, 19-22, 24-29, 34 and 42-50 stand rejected under 35 U.S.C. §102(b) as anticipated by Takayama, Japanese Patent Application Publication Number 2000-268443 (hereinafter *Takayama*);
- Claims 2, 11, 23 and 35-41 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Takayama* in view of Morita, U.S. Pat. No. 5,612,827 (hereinafter *Morita*);
- Claims 9, 17, 32 and 33 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Takayama* in view of Amamiya, Japanese Patent Application Publication Number 2000-295507 (hereinafter *Amamiya*);
- Claim 30 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Takayama* in view of *Amamiya*, and further in view of Kita, U.S. Pat. No. 5,199,593 (hereinafter *Kita*); and
- Claim 31 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Takayama* in view of *Amamiya*, and further in view of Heigl, U.S. Pat. No. 4,746,796 (hereinafter *Heigl*).

Applicant hereby traverses the outstanding rejections of the claims, and request reconsideration and withdrawal of the outstanding rejections in light of the amendments and remarks contained herein. Claims 1, 10, 19 and 35 are amended above for the sole purpose of providing clarification and not for a substantial reason related to patentability. Claim 17 is amended to add the limitation “using a tape characteristic differing from standard type tapes.” Support for this amendment can be found in the first paragraph of page 8 of the present specification. No new matter has been added by these amendments. Claims 1-17 and 19-50 are currently pending in this application.

**II. Objection to the Drawings**

In the Office Action the Examiner objected to the drawing under 37 C.F.R. § 1.83(a) on the premise that “the drawings must show every feature of the claimed invention specified in the claims.” The Office Action indicates that the limitations of claim 30, 31 32 and 33 are not shown in the drawings. Applicant wishes to point out that a “seam” or “joining” 302 of the cartridge, as recited in claims 30, 31 and 32 is shown in FIGURE 3, and that “a spring-loaded tape destruction mechanism” 304 as recited in claim 33 is also shown in FIGURE 3.

As to further detail related to the limitations of claims 30, 31 and 32, Applicant respectfully requests the Examiner to reconsider the objection. Applicant respectfully submits that it is not necessary that every detail of an invention be illustrated by the drawing, unless the form of the device is the principal of the invention, *Sterns v. Tinker & Rasor*, 116 USPQ 222, 227 (1958). Similarly, M.P.E.P. § 608.02(f) provides that the requirement that all modifications described must be illustrated does not apply to a mere reference to minor variations. The limitations of claims 30, 31 and 32 not shown in detail in FIGURE 3, welds, glue and snap fitting, respectively, are minor variations of a limitation of claim 17, “at least one mechanism operable in response to opening said tape cartridge to render said tape unusable.” Therefore, Applicant asserts that in order to redress the Examiner's objection to the drawings several additional FIGURES would be required to illustrate the minor variations of seams, or cartridge fittings. Accordingly, Applicant requests that the Examiner reconsider the drawing objection in view of *Sterns* and the provisions of M.P.E.P. § 608.02(f).

**✓ III. Rejection(s) under 35 U.S.C. §102(b)**

Claims 1, 3-8, 10, 12-16, 19-22, 24-29, 34 and 42-50 are rejected under 35 U.S.C. §102(b) as anticipated by *Takayama*. Applicant has amended independent claims 1, 10, 19 and 35 above to clarify that the “characteristic differing from standard type tapes” is a characteristic of the tape medium itself. Basis for this limitation exists in dependent claims and in the paragraph beginning on line 1 of page 8 of the specification. No new matter has been entered.

**The recited reference does not teach all claimed limitations.**

It is well settled that to anticipate a claim, a reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy at least these requirements.

**Independent claims 1, 10 and 19, as amended, and claim 42** define a tape having “a tape characteristic differing from standard type tapes,” or a similar limitation. *Takayama* does not disclose at least this limitation. The Office Action cites paragraph 14 of *Takayama* in addressing this limitation, prior to amendment. Paragraph 14 of *Takayama* discloses the physical layout of a tape cartridge with memory. However, in addressing the tape itself, *Takayama*, in paragraph 14 only discusses the reels on which the tape is wound and a width of 8mm. The remaining portion of paragraph 14 is principally devoted to describing the memory chip. Applicant fails to understand how this disclosure anticipates the recited tape having “a tape characteristic differing from standard type tapes,” or a similar limitation. Applicant respectfully requests clarification.

Applicant notes that in addressing dependent claims 28, 29, 34 and 47 the Office Action cites paragraphs 43-47 of *Takayama* as anticipating limitations defining the aforementioned tape characteristic as “a write density of said tape.” As can best be gleaned from the provided translation of these paragraphs, this portion of *Takayama* appears to deal with data structure rather than write density or any other characteristic of the tape. These paragraphs describe dividing the tape into partitions, which can be independently accessed. The partitions are described as having groups made up of 20 frames, with each frame made up of two trucks, with each truck formed of 471 blocks. Nothing in this recitation of *Takayama* would seem to indicate that this data structure would vary in write density or any other tape characteristic from that of a standard type tapes.

Thus, Applicant respectfully contends that *Takayama* does not teach (or suggest) the claimed “a tape characteristic differing from standard type tapes”. Therefore, Applicant respectfully asserts that at least for the above reasons independent claims 1, 10, 19 and 42 are patentable over the 35 U.S.C. §102 rejection of record. Furthermore, there are great differences between these claims and the prior art of record and a person of ordinary skill in the art considering the prior art would not find these differences obvious.

Claims 3-8 and 28 ultimately depend from base independent claim 1, and thus inherit all limitations of claim 1. Claims 12-16 and 29 ultimately depend from base independent claim 10, and thus inherit all limitations of claim 10. Claims 20-22, 24-27 and 34 ultimately depend from base independent claim 19, and thus inherit all limitations of claim 19. Claims 43-47 ultimately depend from base independent claim 42, and thus inherit all limitations of claim 42. Therefore, for at least the reasons advanced above in addressing the anticipation rejection of claims 1, 10, 19 and 42, each of claims 3-8, 12-16, 20-22, 24-29, 34 and 43-47 set forth features and limitations not recited by *Takayama*. Furthermore, as pointed out above *Takayama* fails to disclose the “write density” limitation of claims 28, 29, 34 and 47. Thus, Applicant respectfully asserts that at least for the above reasons claims 3-8, 12-16, 20-22, 24-29, 34 and 43-47 are patentable over the 35 U.S.C. §102 rejection of record.

**Independent claim 48**, in part, defines “determining, based on the cartridge type information, whether the tape cartridge is one of a read/write cartridge and a write-once-read-many (WORM) cartridge” and “in response to a determination that the tape cartridge is a read/write cartridge, enabling the tape drive to perform overwriting and erasing of data on the read/write cartridge.” *Takayama* does not disclose at least these limitations. The Office Action addressees these limitations by citing paragraphs 6, 9-11, 13, 71 and 72 of *Takayama*. Paragraph 6 of *Takayama* only teaches provision of a drive capable of writing or recording to a tape and the use of the memory to indicate tape management information. Nothing in this paragraph teaches overwriting and erasing data on a read/write cartridge or identification of a cartridge as a read/write cartridge. In contrast, paragraph 9 of *Takayama* specifically teaches that the drive is controlled to **not** erase, overwrite or change data. Paragraphs 10 and 11 go on to describe how the management information may be recorded both in memory and on the tape and are required to match. In paragraph 13 *Takayama* again teaches that the tape may record or reproduce data. However, again *Takayama* fails to teach overwriting and erasing

data on a read/write cartridge. Paragraph 71 of *Takayama* deals with use of a “write protect top address” while paragraph 72 speaks of a “worm flag” field that indicates “normal” and “WORM.” Applicant respectfully contends that *Takaya* does not teach the claimed “determining, based on the cartridge type information, whether the tape cartridge is one of a read/write cartridge and a write-once-read-many (WORM) cartridge” and “in response to a determination that the tape cartridge is a read/write cartridge, enabling the tape drive to perform overwriting and erasing of data on the read/write cartridge.” Therefore, Applicant respectfully asserts that at least for the above reasons claim 48 is patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, there are great differences between the claim and the prior art of record and a person of ordinary skill in the art considering the prior art would not find these differences obvious.

Claims 49 and 50 depend directly from base claim 48, and thus inherit all limitations of claim 48. Therefore, for at least the reasons advanced above in addressing the rejection of claim 48, each of claims 49 and 50 sets forth features and limitations not recited by *Takayama*. Thus, Applicant respectfully asserts that for the above reasons claims 49 and 50 are patentable over the 35 U.S.C. § 102 rejection of record.

#### IV. Rejections under 35 U.S.C. §103(a)

Claims 2, 11, 23 and 35-41 are rejected under 35 U.S.C. §103(a) as unpatentable over *Takayama* in view of *Morita*. Claims 9, 17, 32 and 33 are rejected under 35 U.S.C. §103(a) as unpatentable over *Takayama* in view of *Amamiya*. Claim 30 is rejected under 35 U.S.C. §103(a) as unpatentable over *Takayama* in view of *Amamiya*, and further in view of *Kita*. Finally, claim 31, is rejected under 35 U.S.C. §103(a) as unpatentable over *Takayama* in view of *Amamiya*, and further in view of *Heigl*. Applicant respectfully traverses these rejections.

#### A Prima Facie case of obviousness has not been established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P.

§2143. Without conceding the first and second criteria, Applicant respectfully asserts that the rejections do not satisfy the third criteria.

**The recited combination does not teach or suggest all claimed limitations.**

In the various obviousness rejections of claims 2, 9, 11, 17, 23, 30-33 and 35-41, the Office Action admits that *Takayama* fails to teach various limitations, which the Office Action alleges to be taught by various ones of *Amamiya*, *Kita* and/or *Heigl*. However, these various combinations, as presented, do not teach or suggest all limitations of the claimed invention.

Specifically, in addressing claims 2, 11, 23, and 35-41, the Office action admits that *Takayama* “fails to mention ejecting the cartridge in response to the drive being unable to recognize the information from the memory device.” The Office Action attempts to address this deficiency by introducing *Morita* which the Office Action alleges to teach that “[i]n the event that the data read from the cartridge is not recognizable or invalid, the cartridge is ejected from the drive.” However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claims 2, 11 and 23 depend from base independent claims 1, 10 and 19, respectively. As pointed out above in addressing the anticipation rejections of claims 1, 10 and 19, *Takayama* fails to disclose or suggest “a tape characteristic differing from standard type tapes,” or a similar limitation recited by each of these independent claims. *Morita* is not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references does not teach all elements of dependent claims 2, 11 and 23.

Furthermore, claims 2, 11 and 23 each recite limitations such as “said drive ejects said cartridge in response to said drive being unable to recognize said information from said memory device.” *Morita* teaches ejection of a cartridge in response to being unable to recognize the grade of a tape from physical holes in the tape’s case. Thus, neither *Takayama* nor *Morita*, alone or in combination, teach or suggest ejecting a cartridge in response to being unable to recognize information in a cartridge memory device.

In addressing claims 35, 38, and 39, the Office Action states “claims 35, 38, and 39 have limitations similar to those treated in the above rejections of claims 1, 2, and 3 respectively and are met by the references as discussed above.” Applicant cannot parse this rejection. As discussed above, claims 1 and 3 were rejected as anticipated by *Takayama*. However, respective claims 35 and 39 are indicated as being rejected as obvious in light of *Takayama* and *Morita*. Accordingly, Applicant respectfully submits that the rejection of claims 35 and 39 do not comport with Office policy. Specifically, the Examiner is directed that “[i]n accordance with the patent statute, ‘Whenever, on examination, any claim for a patent is rejected, or any objection . . . made’, notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given,” M.P.E.P. § 707. As such, the Examiner has not “clearly articulate[d] any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity,” M.P.E.P. § 706. Applicant therefore requests that the Examiner set forth the grounds for rejection with respect to claims 35 and 39 in order that Applicant may have a full and fair opportunity to explore the patentability of these claims.

**Regardless, independent claim 35**, as amended, recites “using a tape characteristic differing from standard tapes of a same format” and “means for reading data from said tape and writing data to said tape using said characteristic differing from standard tapes of a same format.” As discussed above, *Takayama* fails to disclose these limitations. Further, *Morita* is not relied up as disclosing these limitations. Therefore, independent claim 35 is not anticipated by *Takayama* nor obvious in light of *Takayama* and *Morita*.

Claims 36-41 ultimately depend from base independent claim 35, and thus inherit all limitations of claim 35. Therefore, each of claims 36-41 set forth features and limitations not recited by *Takayama*, alone or the combination with *Morita*. Thus, Applicant respectfully asserts that for at least the reasons advanced above in addressing the rejection of independent claim 35, claims 36-41 are patentable over the 35 U.S.C. § 103(a) rejection of record. Furthermore, as pointed out above *Takayama* fails to disclose the “write density” limitation of claims 37 and 41 and *Morita* fails to disclose ejection of a tape upon a drive “being unable to recognize said information from said memory device” (emphasis added).

In addressing claims 9, 17, 32, and 33 the Office Action admits that *Takayama* “fails to mention a tape destruction mechanism operable in response to opening the tape cartridge to render the tape unusable.” The Office Action attempts to cure this deficiency by introducing *Amamiya*, which the Office Action alleges to teach “an electronic device, which contains a spring-loaded mechanism that can destroy a magnetic tape (Fig. 4, element 28) enclosed within in the event that the enclosure of the device is opened.” However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

**Independent claim 17**, from which claims 32 and 33 depend, has been amended to include the limitation “a tape characteristic differing from standard type tapes.” Claim 9 depends from independent claim 1, which as discussed above base independent claim 1 defines the tape having a “characteristic differing from standard type tapes.” As pointed out above *Takayama* does not disclose at least the limitation of “a tape characteristic differing from standard type tapes.” *Amamiya* is not relied upon in the Office Action as disclosing this limitation. Therefore, the combination of references does not teach all elements of the claimed invention.

Claims 30 and 31 also depend from base independent claim 17, and thus inherit all limitations of claim 17. Therefore, each of claims 30 and 31 set forth features and limitations not recited by the combination of *Takayama* and *Amamiya*. Thus, Applicant respectfully asserts that at least for the reasons advanced above in addressing the rejection of claim 17, claims 30 and 31 are patentable over the 35 U.S.C. § 103(a) rejection of record.



**V. Conclusion**

For all the reasons given above, the Applicant submits that the pending claims distinguish over the prior art of record under 35 U.S.C. §§102 and 103. Accordingly, Applicant submits that this application is in full condition for allowance and the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10011666-1 from which the undersigned is authorized to draw. Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes a discussion would be helpful in resolving any remaining problems.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 256028946 US in an envelope addressed to: M/S Non-Fee Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: March 25, 2004

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